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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,957	04/27/2005	Martin Freudiger	P/1336-196	2031
2352 7590 04/05/2010 OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403				
EXAMINER				
MARCO'ANTONI, PAUL D				
ART UNIT		PAPER NUMBER		
1793				
MAIL DATE		DELIVERY MODE		
04/05/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/532,957

**Applicant(s)**

FREUDIGER, MARTIN

**Examiner**

Paul Marcantoni

**Art Unit**

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 February 2010.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.  
4a) Of the above claim(s) 17-31 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-16 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☒ Claim(s) 1-31 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/ISD)  
Paper No(s)/Mail Date 2/4/10: 4/27/05  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

Response to Restriction and Election:

The applicants' election of Group I, claims 1-16, to a construction material, without traverse, and election of *Miscantus* (China Reed) as the plant basis species is respectfully acknowledged.

35 USC 102/103:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over *Rechichi '381 B1*, *Berg '087*, WO 0206182 (Devlin), XP 002242677 (or JP 54025925 A), DE 19526541 (Killmer), US 2002/059886 A1 (Luo), CH 688721 (Zewag), DE 3632394 A (Basalin), DE 10050134 A, (Groetz), EP 016727 A (Scheiwiller), DE 884088 (Bauer), or WO 9709492 A (Graf).

Note: Only the Italicized references were examiner cited references. The remaining references were X or Y references from International Search Report (PCT).

All of the above cited references teach at least a binder, calcium carbonate, and magnesium carbonate in amounts anticipating applicants' claims. Even if not

anticipated, overlapping ranges of amounts would have been prima facie obvious to one of ordinary skill in the art (See claims). It is also noted that full faith and credit has been taken in the search of Examiner Gatterer of the EPO apparently who did the search.

The examiner notes that his cited references can be overcome by the insertion of Portland cement into independent claim 1. The prior art the examiner cited does not teach Portland cement in the amounts claimed by applicants. The examiner has adopted the international examiner's rejection and reasons for rejection as well and any arguments will likely now be the same.

35 USC 112 Second Paragraph:

Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

The term "weight proportions" should be weight percent. There is no indication of the units of percent whether weight or volume percent. The applicants may also consider inserting a --wt%--- before each amount in claim 1.

The terms "on a plant basis" is vague. It appears that applicants should amend their claim so it is clear that the plant basis is a component. Consider amending to a -- plant basis component--- and deleting the PB abbreviation and parentheses. The M1 and M2 seem ok to leave in claim.

Claim 1 would appear indefinite in that applicants do not particularly point out and distinctly claim the range of amounts of plant basis component in their composition based on the other components.

Also, in claim 1, is the total weight percent based on 100% for the whole composition or a higher number? That should be defined in claim 1. Weight percent based on a total weight percent of 100%-- because potentially it could be higher and without that statement in the claim it is not clear if 100%, 110%, 120%, etc.

The applicants also do not particularly point out the identity of their binder as Portland cement which appears to be critical to their invention. The binder otherwise could be anything, even an organic material or organic binder such as polyvinyl alcohol or some resin or polymer which may not obtain the sound insulation properties applicants wish for in their intended use as highway barrier.

In claim 4, possibly amend "weight proportions to weight percent" or just use wt% for each range of amounts provided in the claim.

Claim 6 would appear indefinite only in that it is unclear how much starch is added which is critical to applicants' invention.

The use of abbreviations in claims should be discouraged as well as parentheses when possible. Delete (PB) as plant basis is already written out. Consider also amending to --plant basis component-- for more clarity in claim 9.

The parentheses around (China Reed) seem ok as it defines miscantus in claim 9.

Delete "PB" in claims 11-14 and make term --plant basis component-- for clarity in these claims or any other claims used.

The terms "consistency K1" would appear indefinite as it is unclear what K1 is here. Consider amending claim 13 to --consistency K1 wherein K1 equals the stiffness

of the fresh concrete moister than moist earth and loose when shaken---. The examiner obtained this from [0023] of applicants PG Pub (Published application) for the instant application. Also make the "1" in K a sub 1 and not written as the examiner did but written as applicants did before in the specification and claims.

The applicants may consider amending fungicidal preparation to --fungicide--in claim 15. It will be a search term more prevalent (fungicide) and common in the art. And will be found easier in a search which could help better protect applicants invention should it become allowable at some point. An examiner might not find "fungicidal preparation" but would find more easily --fungicide--.

Finally, the terms "strength class 52.5" is vague. What does this mean in claim 16?

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is 571-272-1373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Paul Marcantoni/  
Primary Examiner, Art Unit 1793